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Remarks

A. Claim Objections

Applicant has made the claim amendments requested by the Examiner. All objections should be removed.

B. Res Judicata Rejection.

The Examining Attorney has rejected claims 20-23 under the doctrine of *Res Judicata* based on the decision made on August 31, 2005 by the Board of Patent Appeals and Interferences affirming the rejection of Facey et al. in view of Pasbrig and the rehearing decision made on November 17, 2005 by the Board of Patent Appeals and Interferences to affirm the rejection of Facey et al. in view of Pasbrig. The Examiner's rejection on the basis of *Res Judicata* is improper.

During the Appeal, Applicant made the argument that the Examiner's suggested motivation of convenience of not needing a separate tool for combining the reference is not a motivating factor because in determining whether convenience is a motivating factor the benefit, both lost and gained, should be weighed against one another, based on the *Winner International Royalty Corp v. Wang* case. Applicant presented arguments as to factors that are lost by the combination and these factors outweighed benefit of convenience. The Appeal Board indicated that Attorney arguments are not evidence in making the decision and indicated that Applicant did not provide any evidence on the issue.

Applicant filed a Request for Continued Examination along with the Declaration of James R. Moon. Mr. Moon is an expert in the field and his statements are factual evidence. The Examiner dismissed this evidence as speculative. Applicant filed another Request for Continued

Examination that included prior art that supports James R. Moon's Declaration showing that the general engineering principals set forth in the Declaration are not speculative. Applicant is also enclosing a Declaration from Edward F. Rafalski indicating that James R. Moon's statements are not speculative but factual and definite to a person skilled in the art.

There is new evidence and new record to be considered. [A] new record presents a new issue. *In re Russell*, 439 F.2d 1228, 1230 (CCPA 1971) (*Res Judicata* rejection is improper where there is a new issue). The Examiner's rejection on *Res Judicata* is improper.

Applicant appreciates the Examiner's suggestion of testing. However, Applicant declines to undertake the cost expenditure associated with testing to prove common engineering principles. The Applicant believes the Examiner is predisposed to reject the Application no matter what evidence is provided by the Applicant.

As proof of this predisposition, one of the assertions by Jim Moon's Declaration is that, "a separate tool such as pliers might still be required to move the release lever." The Examiner finds this to be speculative. Page 10 June 6, 2006 Office Action.

The Examiner, in trying to find a reason for supporting the combination of Lyons and Facey, indicates, "[d]oing so, will facilitate the release of the cable because a significant advantage of the cable grip resides in the manner in which the wedge may be shifted from the locked position in which the wedge is forced towards the cable segment to a release position in which the wedge allows movement of the cable segment by using pliers to release the wedge through the release lever." (emphasis added) Page 8 June 6, 2006. The Examiner also cites the prior art for the use of the pliers.

It appears when the Examiner wants to use a statement it is evidence, but when Applicant presents evidence it is speculative.

Pliers are a separate tool, just like the separate tool provided for in Facey. That fact that pliers, a separate tool, are required with use of the wedge having a release lever directly attached to the wedge is enough to remove the Examiner's "convenience motivation" that no separate tool would be required.

Apparently the Examining Attorney disagrees with the basic engineering principles stated by James R. Moon. If the Examiner contradicts these assertions based on facts within the Examiner's personal knowledge, Applicant respectfully requests and is calling for, pursuant to MPEP Section 2144.03 and 37 C.F.R. Section 104, the Examiner to support such facts by an Affidavit.

Applicant respectfully cautions the Examiner about making conclusions not supported by objective evidence. As set forth in the very recent case of *In re Lee*, 61 USPQ2d 1430 (CAFC January 18, 2002):

As applied to the determination of patentability *vel non* when the issue is obviousness, "it is fundamental that rejections under 35 U.S.C. §103 must be based on evidence comprehended by the language of that section." *In re Grasselli*, 713 F.2d 731, 739, 218 USPQ 769, 775(Fed. Cir. 1983). The essential factual evidence on the issue of obviousness is set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 17-18, 148 USPQ 459, 467 (1966) and extensive ensuing precedent. The patent examination process centers on prior art and the analysis thereof. When patentability turns on the question of obviousness, the search for and analysis of the prior art includes evidence relevant to the finding of whether there is a teaching, motivation, or suggestion to select and combine the references relied on as evidence of obviousness. See, e.g., *McGinley v. Franklin Sports, Inc.*, 262 F.3d 1339, 1351-52, 60 USPQ2d 1001, 1008(Fed. Cir. 2001) ("the central question is whether there is reason to combine [the] references," a question of fact drawing on the *Graham* factors).

"The factual inquiry whether to combine references must be thorough and searching." *Id.* It must be based on objective evidence of record. This precedent has been reinforced in myriad decisions, and cannot be dispensed with.

Applicant disagrees with the Examiner's conclusion that Jim Moon's statements are speculative. Applicant has provided the Declaration of Edward F. Rafalski indicating that the prior art does support Mr. Moon's Declaration and that the points made by Mr. Moon are not speculative but knowledge known to a person having ordinary skill in the art.

B. 35 U.S.C. 103 rejection based on Facey in view of Pasbrig

The Examiner must show motivation to combine the references of Facey and Pasbrig. The Examiner has claimed the following motivation:

- 1) Pasbrig teaches using a release lever that transmits the unclamping force directly to the wedge means; and
- 2) If the release lever is directly attached a need for a separate tool is not required.

1. Unclamping force directly to the wedge means

Facey's tool directly transmits the unclamping force to the wedge means. Therefore, direct force would not be a motivating factor to combine Facey and Pasbrig.

2. Separate tool not required

The Applicant has provided ample evidence of why this is not a motivating factor in the form of James R. Moon's declaration, Alvin F. Coughenour's declaration and patents. The Examiner has in fact acknowledged that a separate tool such as pliers are still required when the release lever is attached to the wedge means.

There is no motivation or suggestion to combine Facey and Pasbrig.

C. 35 U.S.C. 103 Rejection Facey in view of Lyons.

Applicant is submitting a 131 Declaration showing a prior invention date to Lyons.
Therefore, Lyons is not a proper basis for a rejection.

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CONCLUSION

In view of the above, it is submitted that the claims now presented in the application are in condition for allowance. Accordingly, reconsideration and allowance of the claims are requested.

Respectfully submitted,

A handwritten signature in cursive script that reads "John C. Thomas III".

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